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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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GRAHAM & JAMES
885 THIRD AVENUE
NEW YORK, NY 10022

EXAMINER

STEPHANY, TIMOTHY J

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/581,928

Applicant(s)

CASTET ET AL.

Examiner

Timothy J. Stephany

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/6-19-00</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Specification

The disclosure is objected to because of the following informalities:

On page 6, line 9: misspelled word "digitise" should be "digitize".

On page 18, line 11: the phrase "Figure 2" at the bottom of the page to be removed.

Appropriate correction is required, even if the given line locations of the errors are not figured the same by the applicant.

Drawings

The drawings (Figure 1 and Figure 2) are objected to because the figure components are not labeled. Each element of the drawings needs to be labeled with a name corresponding to the labels given the character references in the specification. This is required when such elements are not inherently identifiable to anyone skilled in the art by the structure shown in the drawings. A proposed drawing correction or corrected

drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the steps in the process defined by claims 1-13 and essential to claims 14-18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 14 is objected to because of the following informalities:

On page 16, claim 14, line 3: word misspelled, "characterised" should be spelled "characterized".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 11, 14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Keller ('656).

Regarding **claim 1**, Keller discloses a method of communication by electronic mail between two user interfaces (terminals) through a computer network, where a first user sends an e-mail with an action or command embedded therein (col. 3, lines 49-51 and Figure 6) and that this is received by a recipient and the command data is extracted and acted upon (col. 3, lines 52-56).

Regarding **claims 2**, Keller discloses that this command is inserted within the message (col. 3, lines 59-60 and Figure 2).

Regarding **claim 11**, the method and act of forwarding a received message to another user, is inherent in transmission of electronic mail (Checco ('898), col. 1, lines 43-44 are supplied as a pertinent reference applied to many message formats (col. 4, lines 48-51).

Regarding **claim 4 and 15**, Keller discloses that the recipient carries out the request by selecting the action upon receipt of the electronic mail object (abstract, lines 4-6).

Regarding **claim 14**, Keller has already been shown to use a user interface, which is equivalent to a terminal, for executing the operations designated by the claim, and rejection is made on the same justification as for that of claims 1 and 2 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller ('656) in view of Motoyama ('110).

Regarding **claim 5**, Keller discloses the method in the rejection to claim 2 above, but does not disclose expressly that it sends in the control data an acknowledgement of reception and its address for the receiving terminal.

Motoyama discloses that the e-mail message may contain a request for acknowledgement of receipt (col. 8, lines 64-66) and that an e-mail message will transmit its address. That these can be used by the receiving terminal is implied in the ability of the said terminal to send an acknowledgement to the sending terminal.

Regarding **claim 6**, Keller discloses the method in the rejection to claim 2 above, but does not disclose expressly that a mail reference is inserted in the message.

Motoyama has already been shown to contain the mail reference that is used by the receiving terminal and inserted into the acknowledgement, which is taken to be the network address of the transmitting terminal.

Regarding **claims 7-9**, Keller and Motoyama disclose the method in the rejection to claim 6 above, but do not disclose expressly that control data for validation of

reception is inserted in the message and that upon reception of the acknowledgement the meaning of the data is sought and the reception validated.

Motoyama discloses that upon the sending of the message, that there is the capacity of acknowledgement to secure validation of the success of the transmission and that this is done by measuring a predetermined period of time and that if this has occurred, then a change in state causes the mail to be sent again (col. 8, lines 64-66). The specific details of this process are implied within the function of the apparatus used for the communication and verification.

Keller & Motoyama are combinable because they are from the same field of endeavor and thus constitute analogous art, being that of data transmission across a computer network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have a process of network communication between two terminals, whereby control data is inserted into the message of the e-mail, along with the address of the sender and a request for acknowledgement of reception, with a return mail reference (address), and a means of receiving the confirmation of reception, or otherwise, in its absence during a period of time to have a change in state that results in the resending of the mail.

The suggestion/motivation for doing so would have been that the use of particular modes of communication and handshaking between devices is applicable to any computer network system, regardless of their specific use.

Therefore, it would have been obvious to combine Keller with Motoyama to obtain the invention as specified in claims 5-9.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keller ('656) in view of Motoyama ('110).

Keller discloses the method in the rejection to claim 14 above, but does not disclose expressly that control data for validation of reception is inserted in the message and that upon reception of the acknowledgement the meaning of the data is sought and the reception validated.

Motoyama discloses that upon the sending of the message, that there is the capacity of acknowledgement to secure validation of the success of the transmission and that this is done by measuring a predetermined period of time and that if this has occurred, then a change in state causes the mail to be sent again (col. 8, lines 64-66). The specific details of this process are implied within the function of the apparatus used for the communication and verification.

Keller & Motoyama are combinable because they are from the same field of endeavor and thus constitute analogous art, being that of data transmission across a computer network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have a terminal to implement a process of network communication between two terminals, whereby control data is inserted into the e-mail, whereby the message data content can be determined, along with a request for acknowledgement of

reception, and a means of receiving the confirmation of reception as a means of validation.

The suggestion/motivation for doing so would have been that the use of particular modes of communication and handshaking between devices is applicable to any computer network system, regardless of their specific use.

Therefore, it would have been obvious to combine Keller with Motoyama to obtain the invention as specified in claim 17.

Claims 3, 10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller ('656) in view of Hochman ('685).

Regarding **claim 3**, Keller discloses the method in the rejection to claim 2 above, but does not disclose expressly that the message contains a field of descriptors of the file format with control data inserted. Hochman discloses that the e-mail header (also called control data) includes a field which identifies the character (file format) of the e-mail message portion (col. 3, lines 57-62).

Regarding **claim 10**, Keller discloses the method in the rejection to claim 2 above, but does not disclose expressly that it sends in the control data capabilities of the sending terminal to the receiving terminal, and the receiving terminal sends its capabilities back to the sending terminal.

Hochman discloses that the reception facility performs a check to confirm whether the message type identified in the header is compatible with the recipient's reception apparatus (col. 4, lines 62-66) and that this message type information also

implies the capabilities of the sending apparatus (col. 3, lines 60-62). After the reception, a confirmatory signal may be transmitted back to the sender, so that routines may be provided to process the data file to a format which can be handled by the recipient (col. 5, lines 1-4), which implies that capability information of the receiving apparatus is included in the confirmatory signal.

Regarding **claim 12**, Keller discloses the method in the rejection to claim 2 above, but does not disclose expressly that the command data for printing is inserted by the receiving terminal to command printing of the message upon reception.

Hochman provides for this in its use of computers that are capable of sending and receiving fax transmissions (col. 1, lines 59-61), since fax machines receive and print the output, and thus is obvious given the provisions disclosed in Hochman.

Regarding **claim 13**, Keller discloses the method in the rejection to claim 1 above, but does not disclose expressly that information of file format is attached to the message and that the receiving terminal determines if it can properly reconstruct the file and if not to notify the sending terminal of this.

Hochman discloses that the e-mail transmission includes a header field which identifies the character of the e-mail message portion (col. 3, lines 59-62) and that upon reception, the reception facility performs a check to confirm whether the message type identified in the header is compatible (re-constructible) with the recipient's reception apparatus (col. 4, lines 62-66) and that this message type information also implies the capabilities of the sending apparatus (col. 3, lines 60-62). After the reception, a confirmatory signal may be transmitted back to the sender, so that routines may be

provided to process the data file to a format which can be handled by the recipient (col. 5, lines 1-4), which implies that capability information of the receiving apparatus is included in the confirmatory signal.

Keller & Hochman are combinable because they are from the same field of endeavor and thus constitute analogous art, being that of data transmission across a computer network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have a descriptor field combined with control data; to have a transmission of a message that sends capabilities of the sender and receiver to one another; that the control data contains a command for printing the message; and that given the file format it can be determined if the receiver is able to reconstruct the file and if not that it sends its inability back to the sender.

The suggestion/motivation for doing so would have been that the use of particular modes of communication and data transfer between devices is applicable to any computer network system, regardless of their specific use.

Therefore, it would have been obvious to combine Keller with Hochman to obtain the invention as specified in claims 3, 10, 12 and 13.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller ('656) in view of Hochman ('685).

Regarding **claim 16**, Keller discloses the method in the rejection to claim 15 above, but does not disclose expressly that a data file and the message includes a descriptor field that can be checked by the same means that checks the message.

Hochman discloses that the file has a character identifier (descriptor field) (col. 3, lines 57-62) and that this can be checked when the message is checked when the field is inserted in the address field (col. 4, lines 1-11).

Regarding **claim 18**, Keller discloses the method in the rejection to claim 14 above, but does not disclose expressly that information of file format is attached to the message and that the receiving terminal determines if it can properly reconstruct the file and if not to notify the sending terminal of this.

Hochman discloses that the e-mail transmission includes a header field which identifies the character of the e-mail message portion (col. 3, lines 59-62) and that upon reception, the reception facility performs a check to confirm whether the message type identified in the header is compatible (re-constructible) with the recipient's reception apparatus (col. 4, lines 62-66) and that this message type information also implies the capabilities of the sending apparatus (col. 3, lines 60-62). After the reception, a confirmatory signal may be transmitted back to the sender, so that routines may be provided to process the data file to a format which can be handled by the recipient (col. 5, lines 1-4), which implies that capability information of the receiving apparatus is included in the confirmatory signal.

Art Unit: 2622

Keller & Hochman are combinable because they are from the same field of endeavor and thus constitute analogous art, being that of data transmission across a computer network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have a terminal to implement a process of network communication between two terminals, whereby control data is inserted into the e-mail, whereby the message data content can be determined, to have a descriptor field combined with control data that can be checked; and that given the file format it can be determined if the receiver is able to reconstruct the file and if not that it sends its inability back to the sender.

The suggestion/motivation for doing so would have been that the use of particular modes of communication and data transfer between devices is applicable to any computer network system, regardless of their specific use.

Therefore, it would have been obvious to combine Keller with Hochman to obtain the invention as specified in claims 16 and 18.

Additional Notes

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Patent art Checco ('898) refers to e-mail forwarding; Freeman ('980), Iwamoto ('474), Kaufeld ('967), and Herbst ('170) refer to file information and format in messages; Shaffer ('114), Chang ('449), Nakanura ('789), Toyoda ('278), Hunt ('235) refer to message format; Sakai ('770) and Taylor ('773) refer to message data; Fite ('489) and Iwazaki ('742) refer to capabilities; Okada refers to message notification; and Bashoura ('202) and Pieterse ('127) refer to fax forwarding.


Non-patent art Saito (US 2001/0040693 A1) refers to data transfer; Gross (US 2002/0104021 A1) refers to sending a command to print; Terao (US 2002/0101621 A1) refers to a network method; Hunt (US 2003/0072299 A1) refers to sending files in messages; Ogawa (US 2003/0078982 A1) refers to determining capabilities; and Sato (US 2003/0123083 A1) refers to sending control data.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Stephany whose telephone number is 703-305-8951. The examiner can normally be reached on 8:30 am - 4:30 pm ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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